



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Usha GOSWAMI *et al.*

Title: ***PROBES FOR MYCTOPHID FISH AND A METHOD FOR DEVELOPING THE SAME***

Appl. No.: 09/782,604

Filing Date: 2/14/2001

Examiner: Sally A. Sakelaris

Art Unit: 1634

RECEIVED

MAR 06 2003

RESPONSE TO RESTRICTION REQUIREMENT

TECH CENTER 1600/2900

Commissioner for Patents
Washington, D.C. 20231
Sir:

In response to the restriction requirement set forth in the Office Action mailed February 4, 2003, Applicants hereby provisionally elect Group I, Claims 1-73, for examination. Further, applicants elect the fish "Stenobrachis leucopsarus," mitochondrial gene region, D-loop gene, with PRO-L and D-LOOP H as primers. This response to restriction is made with traverse.

Applicants traverse on the grounds that the examination of only one nucleotide sequence, which would require a separate application for each polynucleotide, is in violation of MPEP §803.04 and the Commissioner's Notice on Examination of Patent Applications Containing Nucleotide Sequences, 1232 OG 242 (116), which both state that "normally ten sequences constitute a reasonable number for examination purposes." This is true even if each nucleotide sequence is an independent and distinct invention under 35 USC §121.

Both the MPEP and the Notice also state "[i]n some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence recited three dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten (10)." The Examiner has proffered no reason as to why any of the claimed several sequences are an exceptional circumstance that necessitates deviation from the normal practice of the MPEP and the Commissioner's Notice.

The Commissioner decided *sua sponte* to waive the requirements of 37 CFR §1.141 *et seq.* to permit the claiming of a reasonable number of nucleotide sequences in an application,

thereby to "aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office." Applicants urge that in these times of scarce capital and deflated stock prices for biotechnology companies, the Commissioner's Notice is even more critical now than it was in March 2000.

Receipt of the initial Office Action on the merits is awaited.

Respectfully submitted,

Date March 4, 2003

By



FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Telephone: (202) 672-5300
Facsimile: (202) 672-5399

Matthew E. Mulkeen
Registration No. 44,250

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.